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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/834,511
Filing Date: April 13, 2001
Appellant(s): KITSUKAWA ET AL.

Kitsukawa, et al.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 06/28/05 appealing from the Office action
mailed 06/06/05.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of the claims contained in the brief is incorrect. For clarification purposes it is noted that the current status of the claims is as follows:

Claims 1-25 are pending, Claims 26-37 have been canceled and Claims 1-25 are the subject of this appeal.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

6,317,881	Shah-Nazaroff et al.	11-2001
6,742,033	Smith et al.	05-2004
5,699,107	Lawler et al.	12-1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 15 and 18-25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Shah-Nazaroff et al. in view of Smith et al. This rejection is set forth in a prior Office Action, mailed on June 6, 2005.

Claims 2-4 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. in view of Lawler et al. This rejection is set forth in a prior Office Action, mailed on June 6, 2005.

Claims 5-14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. and Lawler et al. and further in view of Shah-Nazaroff et al. This rejection is set forth in a prior Office Action, mailed on June 6, 2005.

Claims 16-17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Shah-Nazaroff et al. and Smith et al. and further in view of Lawler et al. This rejection is set forth in a prior Office Action, mailed on June 6, 2005.

(10) Response to Argument

- a. Rejection under 35 U.S.C. 103(a) of claim 1 over Shah-Nazaroff in view of Smith.

First, appellant argues that the only thing sent back to the viewer in Shah-Nazaroff is a program list with ratings, not content (appellant's appeal brief, page 4, lines 16-21).

In response, Shah-Nazaroff discloses receiving user input regarding topics of interest (rating programming and indicating future interest in the programming; column 3, lines 23-32) and then providing a program listing to the user customized based upon their previous inputs (column 4, lines 20-42 and column 5, line 41-column 6, line 22). A custom program listing providing the user with information concerning programming they would enjoy clearly meets the broad limitation of "Internet content *regarding* topics of interest", as the downloaded program listing is clearly customized in regards to the users topics of interest. It is further noted that the most basic and widespread form of

content currently available on the Internet is textual content, which would clearly correspond to the listings described by Shah-Nazaroff.

Second, appellant argues that Shah-Nazaroff does not push content based on user-defined content priorities that are keyed to time of day or as the content regarding topics of interest becomes available and prior to receiving a consumer request for the Internet content (appellant's appeal brief, page 4, lines 16-21).

In response, as indicated above and the in rejections of the previous action, Shah-Nazaroff was only relied upon to disclose downloading Internet content regarding topics of interest to the user. These limitations were clearly indicated as not being disclosed by Shah-Nazaroff, which was the entire basis for the 103 rejection utilizing Smith, who does in fact disclose the required limitations.

Third, appellant argues that Smith teaches pre-caching content when the content strategy deems it appropriate, as opposed to when the content becomes available, and further that pushing the content on an availability basis instead of on a programmed caching basis would frustrate the purpose of Smith (appellant's appeal brief, page 5, lines 1-7).

In response, pushing content on an availability system does not at all frustrate the purpose of Smith's pre-caching system, as the availability of the content is obviously an integral part Smith's system. Smith will find content of interest to a user and download it based upon the user's preferences (column 4, line 36-column 5, line 12).

As Smith is downloading content off of the Internet, the content is clearly downloaded when it becomes available, as unavailable content could not be downloaded. The “availability” of the content is a basic requirement for any system to receive content. While Appellant seems to feel that downloading Internet content “as the content...becomes available” somehow translates into immediately downloading the content the instant it becomes available, this is clearly not the case.

Further, the claim does not specify as to whom the “availability” pertains. As the system of Smith will not download the content until the time that the user is expected to desire it, the content is clearly not downloaded until “available” to the *user’s* system. While Appellant seems to feel that downloading Internet content “as the content...becomes available” somehow includes the further limitations of downloading content as it become available *at the content provider*, this is clearly not the case. As the algorithm controlling Smith’s system will only download the content at a particular time, the content is downloaded when it becomes available to the system at the proper time.

Fourth, appellant again argues that Smith doesn’t do anything on an as-available basis, and further that any attempts to read the limitation broadly are “irrelevant” (appellant’s appeal brief, page 5, lines 8-15).

In response, as indicated above, the providing of content on an availability basis is a basic functionality of Smith. Further, the examiner is confused as to how appellant feels that taking a broad interpretation of a claim is “irrelevant”, when, as indicated

above, the current claim limitations are clearly extremely broad with numerous possible interpretations. Appellant's hypothetical arguments simply do not address the fundamental issue, which is that the current claim language does not require any of the narrow, arbitrary limitations that appellant suggests.

Fifth, in response to appellant's arguments that the broad claim interpretations taken towards availability are somehow improper (appellant's appeal brief, page 5, line 16-page 6, line 2), please see above where it has been demonstrated that the current claim interpretations taken are clearly reasonable in regards to the broad limitations that are actually in the claims.

Sixth, appellant argues that the combination of Smith with Shah-Nazaroff would not work as Shah-Nazaroff downloads a program listing and not content (appellant's appeal brief, page 6, lines 3-8).

In response, as indicated above, Shah-Nazaroff clearly discloses downloading "content" in the form of a custom program listing. As the claims simply call for "Internet content", this custom program listing clearly meets the broad limitations. The examiner is confused as to how the word "content", which is an extremely broad term covering virtually anything downloadable from the Internet, such as video, audio, text, etc..., would somehow be interpreted as "Internet content, which is not a program listing" as appellant seems to suggest.

Further, appellant states that claim 1 would not result from the combination due to the fact that the only result would be pre-caching the program list according to Smith's algorithm. As indicated above, this is, in fact, the exact result relied upon to meet the current claim limitations.

Lastly, appellant argues that it would not make sense to combine Smith's pre-caching algorithm with Shah-Nazaroff's program listing because viewers typically desire to review program listings whenever they wish to do so to attain an understanding of future programming.

In response, the examiner asserts that viewers do typically desire to review program listings whenever they wish to do so. The basic functionality of Smith is to determine when a user will *desire* to view a piece of content, such as based on a previous history of always viewing content at a particular time, and to then download it for that before that time (see Smith at column 4, line 62-column 5, line 12). By not downloading the content earlier, when it probably isn't desired, Smith explicitly spells out the benefits of allowing the system to better conserve resources such as bandwidth and memory (column 5, lines 7-12). This functionality and the benefits therein would clearly apply perfectly to a program listing of future programming. If a user typically doesn't view the program listing until later in the day, such as after a day at work, the system can conserve resources by not retrieving the newest program listings until the user is expected to be home and requesting the content. The caching algorithm of

Smith is clearly combinable for use with Shah-Nazaroff's program listings for the prior art benefits explicitly recited by Smith.

b. Rejection under 35 U.S.C. 103(a) of claim 15 over Shah-Nazaroff in view of Smith.

First, appellant argues that the user of Smith does not get to choose what content is displayed when, as this is done automatically by the caching algorithm based on the user's usage patterns (appellant's appeal brief, page 6, line 16-page 7, line 5).

In response, it is noted that the claim does not in fact require "allowing a user to choose what content is displayed when", as appellant implies. The claim limitation actually recites the much broader limitation of downloading content "based on consumer input *regarding* user-defined priority levels of topics of interest for different times of day." Smith specifically discloses receiving user inputs (user Internet usage to access and view different content; column 4, line 62-column 5, line 12) regarding user-defined priority levels of topics of interest for different times of day (wherein the user has defined through their history a priority level for particular content at particular times of day; column 4, line 62-column 5, line 12). Appellant's arguments seem to be based upon limitations which are just not contained within the claims, as there is **no** requirement in any of the current claim language where the user must be providing an *explicit* definition of a priority level. The claims merely recite receiving user inputs *regarding* user-defined priority levels. As the inputs provided by the user in Smith define the priority levels for the topics of interest, they clearly meet the broad claim limitations of claim 15.

Secondly, while appellant vaguely states that a plurality of dependent claim rejections are supposedly defective, only a single instance has been actually indicated, which also does not even specify which claim and limitations it's directed to.

Based upon the claim limitation appellant mentions, "filtering future server queries at least partially based on the consumer interest pattern", it appears that appellant is referring to the rejection of claim 25.

In response, Shah-Nazaroff specifically discloses wherein the server will store a file containing user interest information (column 3, line 63-column 4, line 19) and then filter items from the user query for programming based upon the user file (column 7, lines 20-42). This clearly meets the claim limitation of "filtering future server queries at least partially based on the consumer interest pattern", as recited in claim 25.

c. Rejection under 35 U.S.C. 103(a) of claim 2 over Smith in view of Lawler.

First, appellant implies that the examiner has admitted that Smith fails to allow the user to specify the topic of interest, which might somehow contradict the previous claim rejections (appellant's appeal brief, page 7, lines 15-18).

In response, as indicated above, none of the previous claims required the user to explicitly indicate a specific topic as being of interest. The only requirement of the previous independent claims was towards user input **regarding** topics of interest. As the user inputs are monitored to determine the topics the user is interested in, this

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clearly meets the broad limitations of the previous claims as to *regarding* topics of interest.

Second, appellant argues that Smith, which is directed to a system for choosing content for a user, and not allowing the user to specify the content, cannot be combined with the reminder of Lawler as the reminder is for a user-selected program (appellant's appeal brief, page 7, line 15-page 8, line 3).

In response, it is noted that Smith was specifically relied upon to teach where a user will access various content (see Smith at column 4, line 62-column 5, line 12), and that a particular topic of interest is inferred from the user's access (see Smith at column 4, line 62-column 5, line 12). Thus content that the user is interested in is retrieved and downloaded for the user at the time the user will most likely want to view the content (see Smith at column 4, line 62-column 5, line 12).

Lawler was only relied upon for the specific teaching of notifying a user that content of interest to them is available for viewing (column 12, lines 35-43).

The benefits of making the user aware that content of interest is available are completely independent of how the content was selected. The fact that Smith discloses an algorithm selecting content you will enjoy, does not somehow negate the possibility, or obvious benefits therein, of notifying the user that content they will enjoy is now available.

Further, the claim only requires that the topic of interest is not specified by the user (as taught by Smith). The combination with Lawler to include a user actively

selecting to have a reminder system activated continues to fully meet the claim limitations. Allowing a user to active a notification allows the user to actively choose whether or not to be notified when content predicted to be of interest to the user has been downloaded.

In response to appellant's statements, in the first recitation of two identical paragraphs with neither referring to any specific rejection (appellant's appeal brief, page 8, lines 5-7), citing a lack of prior art motivation, which the examiner assumes is directed to the combination of the Shah-Nazaroff and Smith references, please see above where the motivation for the combination has been previously spelled out.

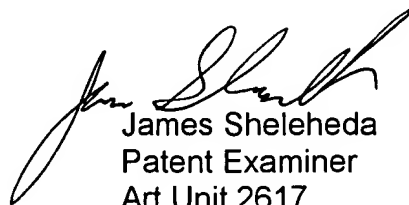
In response to appellant's statements, in the second recitation of two identical paragraphs with neither referring to any specific rejection (appellant's appeal brief, page 8, lines 9-11), citing a lack of prior art motivation, which the examiner assumes is directed to the combination of the Smith and Lawler references, please see above where the motivation for the combination has been previously spelled out.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



James Sheleheda
Patent Examiner
Art Unit 2617

JS
October 13, 2005

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